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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/705,838	11/03/2000	Yoshio Nakagawa	207138	8053

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/705,838

Applicant(s)

NAKAGAWA ET AL.

Examiner

Victor S Chang

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 07 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached NOTE.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1,2,6-12,15-20.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300

1700



NOTE

Applicants' response dated 11/7/2003 has been carefully considered. In particular, with respect to Applicants' argument that "the ethylene:propylene monomer ratio of CATALLOY KS-353P is not relevant to the demonstration that the disclosure of Tucker et al. does not anticipate or render obvious the present invention" (Remarks, page 2, third paragraph), the Examiner repeats (see Paper No. 16, page 2) that ~~while~~ Applicants' response and Mr. Yoshio Nakagawa's Declaration appear to be persuasive that the multi-step polymerized and mechanically blended propylene/ethylene copolymers are structurally (or morphologically) different from Tucker's EP copolymer made by solution or suspension methods (Remarks, page 3, first full paragraph). However, the Examiner again repeats that Applicants' Remarks is deficient in that Applicants merely stated that the "the evidence of record clearly demonstrates that the use of the most similar component actually disclosed in Tucker et. (i.e., Epsyn 7506) does not result in either the substrate or the adhesive tape defined by the pending claims" (Remarks, page 3, second full paragraph). As such neither the Remarks, nor the Declaration by Mr. Yoshio Nakagawa has sufficiently disclosed the composition ratio of ethylene and propylene in EPR, which renders the comparison study inadequate, i.e., it fails to illustrate that the tests are carried out under comparable conditions. If further prosecution, i.e., a CPA or RCE, is contemplated, the Examiner would like to again strongly urge Applicants further fairly limit the composition (i.e., propylene/ethylene

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monomer ratio) to the same range, so as to clearly demonstrate that the performance difference is the result of distinct morphology alone of the instant invention.

With respect to Applicants' argument that "Richardson et al. does not disclose a propylene/ethylene copolymer of any type" (Remarks, page 3, bottom paragraph), the Examiner notes that Applicant clearly argues the cited references individually. In response to Applicant's arguments, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).